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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,390	07/22/2003	Peter Maiefisch	P1/5-19164/D7	6821

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SYNGENTA CROP PROTECTION, INC.  
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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT PAPER NUMBER

1616

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/624,390

Applicant(s)

MAIENFISCH ET AL.

Examiner

Alton N. Pryor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-15 and 17-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

- I. Rejection of claims under 35 USC 112, 1<sup>st</sup> paragraph will not be maintained. "A" is limited to mono- and bi- cyclic hetero rings.
- II. Rejection under 35 USC 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15,17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiokawa et al (US 5719146; 2/17/98). Shiokawa suggests a compound where A = 2-chloropyridin-5-yl; Z1 = O; X = N; Y = NO<sub>2</sub>; R1 = H; and R2 = CH<sub>3</sub>. See claim 1. Shiokawa teaches an insecticidal composition comprising the compound of claim 1 with an emulsifier (auxiliary). See column 5 lines 52-59, column 6 lines 18-24, column 18 lines 51-57. Shiokawa teaches a method of applying the composition onto insects or seedlings in order to protect plants from pests. See abstract, column 4 lines 23-30, column 18 lines 59-62. Shiokawa's compound is equivalent to instant compound where A = 2-chloropyridin-5-yl; X = NNO<sub>2</sub>; and R = methyl. Shiokawa does not exemplify a compound wherein Z1 is oxygen. However, it would have been obvious to one having ordinary skill in the art to have made the invention wherein Z1 is oxygen at the time of Shiokawa's invention. One would have been motivated to do this since Shiokawa strongly suggests the compound. See claim 1. In addition such a compound would have been structurally similar to all of Shiokawa's exemplified compounds and therefore

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would have been expected to yield similar activity. Note structurally similar compounds would have been expected to give similar results in activity tests.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15,17-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6376487. Although the conflicting claims are not identical, they are not patentably distinct from each other because USPN ' 487 suggests a compound where A = 2-chloropyridin-5-yl; X = NNO<sub>2</sub>; R = CH<sub>3</sub>. See claim 1. USPN ' 487 teaches an insecticidal composition comprising the compound of claim 1 with a diluent (auxiliary). See claim 3. USPN ' 487 teaches a method of controlling insects comprising applying the composition onto insects or into their habitat. See claim 4. USPN ' 487 compound is equivalent to instant

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compound where A = 2-chloropyridin-5-yl; X = NNO<sub>2</sub>; and R = methyl. USPN ' 487 does not specifically claim this compound. However, it would have been obvious to one having ordinary skill in the art to have made the invention comprising this compound. One would have been motivated to do this since USPN ' 487 strongly suggests the compound. See claim 1.

Claims 1,17,22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5852012. Although the conflicting claims are not identical, they are not patentably distinct from each other because USPN '012 suggests a compound where A = 2-chloropyridin-5-yl; X = NNO<sub>2</sub>; R = CH<sub>3</sub>. See claim 1. USPN '012 teaches a pesticidal composition comprising the compound of claim 1 with a carrier (auxiliary). See claim 1. USPN '012 teaches a method of controlling pests comprising treating seed with the compound. See claim 1. USPN '012 compound is equivalent to instant compound where A = 2-chloropyridin-5-yl; X = NNO<sub>2</sub>; and R = methyl. USPN '012 does not specifically claim this compound. However, it would have been obvious to one having ordinary skill in the art to have made the invention comprising this compound. One would have been motivated to do this since USPN '012 strongly suggests the compound. See claim 1.

### ***Claim Objection***

Claim 21 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

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dependent form, or rewrite the claim(s) in independent form. Method claim 21 is distinctly different from method claim 19 and therefore should not depend from claim 19.

***Other Matters / Suggestions***

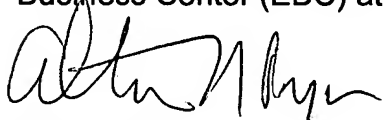
The elected invention is not allowable. See rejections above. In claim 4 line 2 delete " and including".

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alton Pryor  
Primary Examiner, AU 1616